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10/620,233	07/14/2003	Patrick J. Kelly	55474/7	8520

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KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

COBANOGLU, DILEK B

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3626

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/620,233
Filing Date: July 14, 2003
Appellant(s): KELLY ET AL.

Jonathan S. Caplan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/22/2008 appealing from the Office action mailed 04/09/2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 1 is rejected under 35 U.S.C. 101 for being directed to a non-statutory subject matter because the claimed subject matter failed the machine-or-transformation test. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as article or materials) to a different state or thing (*Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).

With respect to claim 1, the claim language does not include the required tie in the body of the claim or transformation that would provide the application of the test to the claim to reach the conclusion of nonstatutory subject matter.

Claims 1 does not recite a particular apparatus, therefore is rejected under 35 U.S.C. 101, for reciting a non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,389,454	RALSTON et al.	5-2002
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5,940,834	PINARD et al.	8-1999
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Dubois et al. "Source localization following permanent transperineal prostate interstitial brachytherapy using magnetic resonance imaging", *Int. Radiation Oncology Biol. phys.*, Vol. 39, No. 5, pp. 1037-1041, 1997

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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With respect to claim 1, the claim language does not include the required tie in the body of the claim or transformation that would provide the application of the test to the claim to reach the conclusion of nonstatutory subject matter.

Claims 1 does not recite a particular apparatus, therefore is rejected under 35 U.S.C. 101, for reciting a non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al., U.S. Patent No. 6,389,454 in view of Dubois et al., Source Localization Following Permanent Transperineal Prostate Interstitial Brachytherapy Using Magnetic Resonance Imaging (hereinafter, Dubois).

As per claim 1, Ralston teaches a method for health care screening, comprising: contacting a scheduling service (see column 4, lines 6-12); scheduling an MRI procedure via the scheduling service (see column 4, line 65 - column 5, line 5); determining if the MRI procedure can be authorized (see column 4, line 65 - column 5, line 5); and scheduling the MRI procedure (see column 6, lines 17-22) wherein the scheduling includes selecting a location and an unused time slot for the MRI procedure available between scheduled diagnostic MRI procedures at one of a predetermined set of existing procedure facilities affiliated with the scheduling service as a function of location and time parameters of a user and an availability of the predetermined set of procedure facilities (see column 5, lines 41-60).

Ralston does not explicitly teach that the MRI procedure is an abbreviated MRI procedure designed for an asymptomatic individual scheduled with a

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provider capable of performing the abbreviated MRI procedure. However, it is respectfully submitted that abbreviated MRI procedures for asymptomatic individuals along with providers capable of performing them are old and well known in the art as evidenced by Dubois (see page 1 in particular and note that an abbreviated MRI procedure was utilized for the post implant evaluation). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate abbreviated MRI procedures designed for an asymptomatic individuals scheduled with a provider capable of performing the procedure as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

As per claim 2, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the MRI procedure includes a T2 type MRI scan.

However, the Examiner takes Official Notice that T2 type MRI scans are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate T2 type MRI scans as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

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As per claim 3, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the MRI procedure is to be performed on a brain of the user of the scheduling service. However, the Examiner takes Official Notice that MRI procedures performed on the brain of a user are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate MRI procedures performed on the brain of a user as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

As per claim 4, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston further teaches the contacting includes a computer network connection of the user to the scheduling service (see column 4, lines 35-44).

As per claim 5, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston further teaches determining a result of the MRI procedure (see column 7, lines 2-7).

As per claim 6, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the result is determined by a radiologist associated with the procedure facility. However, the Examiner takes Official Notice that MRI procedure results determined by a radiologist are old and well known the art. It would have been obvious to one of ordinary skill in the art at

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the time of the invention to have results be determined by a radiologist. One of ordinary skill in the art would have been motivated to rely on such a professional for the result to facilitate the provision of services in an efficient, cost-effective manner (see column 2, lines 30-35).

As per claim 7, Ralston in view of Dubois teaches the method of claim 6 as described above. Ralston further teaches storing the result by the scheduling service (see column 7, lines 2-7).

As per claim 8, Ralston in view of Dubois teaches the method of claim 2 as described above. Ralston further teaches the predetermined set of existing procedure facilities includes a set of existing MRI facilities (see column 4, lines 12-13 and column 5, lines 2-5).

As per claim 9, Ralston in view of Dubois teaches the method of claim 2 as described above. Ralston further teaches the contacting includes contacting the scheduling service via one of a computer network connection and a voice connection (see column 4, lines 36-44).

As per claim 10, Ralston in view of Dubois teaches the method of claim 9 as described above. Ralston further teaches the computer network connection includes an Internet connection via a web browser (see column 4, lines 36-44).

15. Claims 13-15, and 18-20 recite substantially similar system and article of manufacture limitations to method claims 1-3 and 9-10 and, as such, are rejected for similar reasons as given above.

Claims 11-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al., U.S. Patent No. 6,389,454 in view of Dubois et

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al., Source Localization Following Permanent Transperineal Prostate Interstitial Brachytherapy Using Magnetic Resonance Imaging (hereinafter, Dubois) and further in view of Pinard et al., U.S. Patent No. 5,940,834.

As per claim 11, Ralston in view of Dubois teaches the method of claim 10 as described above. Ralston does not explicitly teach the determining includes presenting at least one web page screen to the user requesting predetermined user personal and medical information. Pinard teaches a method for generating web pages that includes generating a web page for making reservations for facilities (see column 8, line 66 - column 9, line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of facilitating the provision of services in an efficient, cost-effective manner (see column 2, lines 30-35).

As per claim 12, Ralston in view of Dubois and Pinard teaches the method of claim 11 as described above. Ralston further teaches determining if the MRI procedure can be authorized is performed as a function of the user's predetermined personal and medical information (see column 5, lines 2-5).

Claims 16-17 recite substantially similar system limitations to method claims 11-12 and, as such, are rejected for similar reasons as given above.

(10) Response to Argument

Argument A: Dubois does not teach “members of general public looking to schedule a healthcare screening scan”.

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Argument B: Dubois does not teach "asymptomatic individuals".

Argument A:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., members of general public looking to schedule a healthcare screening scan) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument B:

In response to applicant's argument, Examiner respectfully submit that given the broadest reasonable interpretation to one of ordinary skill in the art, the MRI procedure taught by Dubois falls within the scope of the claimed "abbreviated MRI procedure designed for an asymptomatic individual." Dubois clearly identifies the MRI procedure as an "optimized and abbreviated MR scanning sequence" (see page 1). And according to www.dictionary.com "asymptomatic" has a meaning of "showing no evidence of disease"; and the only purpose of the abbreviated MRI procedures of Dubois is to evaluate the brachytherapy implant. They are not, on the other hand, designed to evaluate a particular symptom of the patient.

Examiner also points MPEP section 2141, decision by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007): The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." *Dann v. Johnston*, 425 U.S.

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219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.”*Id.* In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. See 35 U.S.C. 103(a). Factors other than the disclosures of the cited prior art may provide a basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap. The rationales discussed below outline reasoning that may be applied to find obviousness in such cases.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that

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complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/D. B. C./

Examiner, Art Unit 3626

1/14/2009

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/C. G./

Supervisory Patent Examiner, Art Unit 3626

/Vincent Millin/

Appeals Conference Specialist
